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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SLOBODYANSKY, ELIZABETH

ART UNIT PAPER NUMBER

1652

DATE MAILED: 04/29/2004

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,125

Applicant(s)

MARCIREAU ET AL.6

Examiner

Elizabeth Slobodyansky, PhD

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-16,20,25 and 45-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7-16, 20, 25, 45-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The amendment filed on September 22, 2003 amending claims 1, 3, 8, 9, 11, 12, 16, 20, 25, canceling claims 2, 4-6, 17-19, 21-24, 26-44 and adding claims 45-53 has been entered.

Claims 1, 3, 7-16, 20, 25 and 45-53 are pending.

Claim Objections

Claims 1 and 20 are objected to because of the following: MEKK should be spelled out and followed by the abbreviation in parenthesis. Claims 1 and 20 have been amended to recite "upstream threonine kinase (MEKK)". "upstream" refers to the location and is not the spelling of the abbreviation.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 3, 7-16, 20, 25 and 45-53, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, with dependent claims 3, 7-16, 48-53, and claim 20, with dependent claim 25, recite the term "MEKK interacting FHA protein (MIF1)". While "MIF" is the abbreviation of "MEKK interacting FHA", the metes and bounds of the term MIF1 as

compared to MIF are not defined. It is unclear which sequences other than SEQ ID NO: 2 are encompassed by the term "MIF1".

Claim 48 is indefinite as dependent from itself. For the purposes of this examination, claim 48 is construed as dependent from claim 47.

Claims 11 and 48 are unclear as reciting "the plasmid DNA molecule of claim ..., further comprising a composition selected from the group consisting of a DNA condensing protein, a cationic lipid, a liposome, a polymer, and a DNA precipitating agent". A plasmid cannot contain the recited compounds, it contains a DNA. A composition can comprise a plasmid and the recited compounds.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3, 7-16, 20, 25 and 45-53 are rejected under 35 U.S.C. 102(a) as being anticipated by Ren et al.

Ren et al. (May 1, 1998, form PTO-1449, reference B) teach the protein of 462 amino acids that comprises SEQ ID NO:2 of the instant invention (page 735, Figure 1). They teach a DNA encoding thereof comprising SEQ ID NO:1 of the instant invention (GenBank accession AF015308, specification at page 2, lines 13-15). Ren et al. teach vectors and host cells comprising said DNA and its expression.

Ren et al. name the protein "58- kDa microspherule protein (MSP58)" and demonstrate its interaction with nucleolar protein p120. However, whether or not the interaction disclosed by Ren et al. ultimately represents the same function as is discussed in the instant application, the protein remains the same. As such, the protein MSP58 and DNA encoding thereof disclosed by Ren et al. anticipate claims 1, 3, 7-16, 20, 25 and 45-53.

Response to Arguments

The 112, 1st paragraph, rejection is withdrawn in view of the amendment.

Applicant's arguments filed September 22, 2003 have been fully considered but they are not persuasive.

With regard to the 102(a) rejection, Applicants argue that "it is the position of the Examiner that Ren *et al.* disclose of protein MSP58 and the DNA that encodes the protein anticipate Claims 1-3, 6-16, 20-23 and 25-26. Applicants respectfully traverse this rejection. Initially, Applicants respectfully point out to the Examiner that in the instant Amendment, Claims 2, 4-6, 17-19, 21-24, and 26-44 have been canceled, without prejudice. Thus, this rejection with respect to Claims 2, 6, 21-23, and 26 is MOOT. Furthermore, Applicants respectfully submit that the subject matter of amended Claims 1, 3, 8-9, 11-12, 16, 20, and 25, and new Claims 45-53 is novel" (Remarks, page 12). This is not persuasive because while Applicants correctly characterize the examiner's position, they do not provide the reasons rendering it, in Applicants' view, incorrect.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky, PhD whose telephone number is 571-272-0941. The examiner can normally be reached on M-F 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, PhD can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Elizabeth Slobodyansky, PhD
Primary Examiner